

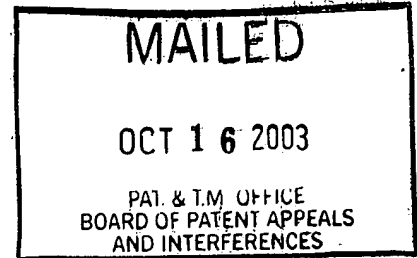
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE TOGNAZZINI

Appeal No. 2002-0081
Application No. 09/153,230

ON BRIEF



Before JERRY SMITH, RUGGIERO, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

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REMAND OF APPEAL

A patent examiner rejected claims 1, 2, 4-17, and 22-42. The appellant appeals therefrom under 35 U.S.C. § 134(a). We remand.

OPINION

"The review authorized by 35 U.S.C. Section 134 is not a process whereby the examiner . . . invite[s] the Board to examine the application and resolve patentability in the first instance." *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (Bd.Pat.App. & Int. 1999). In an *ex parte* appeal, "the Board is basically a board of review — we review . . .

rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (Bd.Pat.App. & Int. 2001).

Here, the examiner bases a rejection on a "judicially created doctrine of double patenting. . . ." (Examiner's Answer at 2.) Specifically, he relies on the doctrine to reject claims 37, 40, and 41 of the appellant's application over claims 1-3 of U. S. Patent No. 5,859,629 ("Tognazzini"). The examiner cites *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968) and M.P.E.P. § 804 in support of the doctrine. (*Id.* at 3.) After considering the record, we are persuaded that "[t]he appeal is manifestly not ready for a decision on the merits." *Braeken*, 54 USPQ2d at 1112. Accordingly, we remand for the following reasons:

- explanation of rejection
- signature of Director.

Explanation of Rejection

In re Schneller applies only to those situations where the following conditions are satisfied. (1) The subject matter recited in a claim of a patent application is fully disclosed in **and** is covered by a claim in a patent (i.e., there has been no improvement or modification invented after filing **and** the application claim reads on subject matter protected by a patent claim). (2) There is no reason that an appellant was prevented

from presenting the same claim for examination in the issued patent (i.e., there is no justification for extending the protection, such as the existence of a restriction requirement). See *Schneller*, 397 F.2d at 355, 158 USPQ at 215; M.P.E.P. § 804 (7th ed., rev. 1, Feb. 2000). The examiner shows satisfaction of neither condition.

First, the examiner does not show that the subject matter recited in claims 37, 40, and 41 of the appellant's application is covered by claims 1-3 of Tognazzini. Regarding the requirement for claim coverage, M.P.E.P. § 804 (7th ed., rev. 1, Feb. 2000) included the following provision at the time of the examiner's answer.

In determining whether to make this type of nonstatutory double patenting rejection, the examiner should do a side by side comparison of the reference and application claims, keeping in mind that "only the claims of the patent can be considered as support for the rejection, its disclosure being looked to only to determine the meaning of the claims, which are to be read in the light of the specification." 397 F.2d at 352, 158 USPQ at 213.

Here, the examiner omits such a side by side comparison. He merely states, "[t]he subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: selection of touch keys modifies a granularity of movement controlled by the strip of touch sensitive material." (Examiner's Answer at 3.)

Second, the examiner does not show that there is no reason that the appellant was prevented from presenting each of claims 37, 40, and 41 for examination in Tognazzini. He merely concludes, "there is no [such] apparent reason." (*Id.*)

Signature of Director

Nonstatutory double patenting rejections based on *Schneller* must be approved by both a Supervisory Patent Examiner and a Technology Center Director. The specific requirement follows.

The Technology Center (TC) Director must approve any nonstatutory double patenting rejections based on *Schneller*. If an examiner determines that a double patenting rejection based on *Schneller* is appropriate in his or her application, the examiner should first consult with his or her supervisory patent examiner (SPE). If the SPE agrees with the examiner then **approval of the TC Director must be obtained before such a nonstatutory double patenting rejection can be made.**

M.P.E.P. § 804 (8th ed., rev. 1, Feb. 2003) (emphasis in original). Here, although the examiner's answer bears the signature of an SPE, (Examiner's Answer at 10), there is no evidence that a TC Director approved the double patenting rejection based on *Schneller*.

"We decline to substitute speculation as to the rejection for the greater certainty which should come from the [examiner] in a more definite [explanation] of the grounds of rejection[.]" *Gambogi*, 62 USPQ2d at 1212. Instead, we remand the application to

the examiner to reconsider the propriety of the double patenting rejection¹ in view of the aforementioned conditions and requirements. In doing so, he should consider the analytical basis for the Board's decision *Ex parte Davis*, 56 USPQ2d 1434 (Bd.Pat.App. & Int. 2000). If after such reconsideration, the examiner believes an obviousness-type double patenting rejection is still proper, we need a full explanation of how each condition and each requirement is satisfied. In particular, we need a side by side comparison of **each** of claims 37, 40, and 41 of the appellant's application with **each** of claims 1-3 of Tognazzini.

Any supplemental examiner's answer submitted by the examiner should be signed by a TC Director (and an SPE). Any such answer should be self-contained with respect to all rejections and arguments; no prior answer or Office actions should be referenced or incorporated therein. Similarly, any supplemental brief submitted by the appellant should be self-contained with respect to all arguments. No prior briefs should be referenced or incorporated therein.

Because it is being remanded for further action, the application is a "special" application. M.P.E.P. § 708.01(D) (8th ed., rev. 1, Feb. 2003). Accordingly, it requires

¹ Claims 1, 2, 4-17, and 22-42 also stand rejected under 35 U.S.C. § 103(a), (Examiner's Answer at 3-6); we will review the substance of those obviousness rejections once the entire appeal is ready for a decision on the merits.

immediate action. Furthermore, the Board should be informed promptly of any action affecting status of the appeal (e.g., abandonment, issue, reopening prosecution).

REMANDED

Gerry Smith
JERRY SMITH

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Joseph V. Russo

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